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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,266	02/21/2002	E. John Deviny	56372US010	9839

32692 7590 11/05/2003

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EXAMINER

PEZZUTO, HELEN LEE

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,266

Applicant(s)

DEVINY ET AL.

Examiner

Helen L. Pezzuto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 16-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-15, and the election of the itaconic di(butyl)ester as per claim 1 in Paper No. 7 are acknowledged.

2. Claims 16-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim: Election was made **without** traverse in Paper No. 7.

Claims 1-15 are currently under consideration in this application.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Deviny (US-208).

U.S. 5,883,208 to Deviny discloses an initiation polymerization system for acrylic monomers, comprising an organoborane amine complex and decomplexers containing at least one anhydride group. Suitable anhydrides include species, which fall within the scope of the presently claimed work-life extending agent such as itaconic anhydride. Prior art further discloses and exemplifies a partial adduct of poly(styrene-co-maleic anhydride) suitably used as a decomplexer, which reads on the instant vinyl aromatic compound expressed in claim 11. Still further, prior art suggest the inclusion of an elastomeric material such as a core-shell polymer, which embraces the limitation expressed in claims 14. Regarding the overlap shear strength and extended open time limitations expressed in claims 12-13, the examiner is of the position that such properties is considered inherent in the prior art because prior art exemplified peel strength between two overlapping

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free ends of the sample as well as the tensile strength and bond strength values for various samples ((col. 12, line 63 to col. 13, line 12; cols. 17-18, Table VI), which are related properties to those claimed. The burden is placed upon applicant to provide clear and convincing evidence that the such properties are not inherent in prior art composition.

6. Claims 1-5, 7-10, and 12-15 are rejected under 35

U.S.C. 102(b) as anticipated by or, in the alternative, under 35

U.S.C. 103(a) as obvious over WO 99/64475.

WO 99/64475 discloses an initiator system for making adhesive compositions, comprising an organoborane amine complex, a decomplexer represented by structure (I) or (II), and optionally a second carboxylic acid decomplexer. Prior art decomplexer shown in formula (I) clearly encompasses the presently claimed work-life extending agent expressed in claims 1 and 4-5. Prior art teaches the suitability of the initiator system for acrylic monomers, and the inclusion of a diluent and core shell polymer as additives. WO-475 discloses and exemplifies overlap shear bond strength and shear values but do not expressively disclosed them in % retainment as expressed in claim 12. The examiner is of the position that such values are

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inherent in prior art overlap shear values, thought silent.

The burden is upon applicant to provide clear and

convincing evidence that such is not the case.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/64475 for the reasons stated in the preceding paragraph and further in view of the following.

Prior art reference does not expressively disclose or exemplify the presently claimed itaconic di(butyl)ester, but clearly teaches the itaconic mono(butyl)ester in structure (I). Since applicant appears to contemplate both the mono(butyl) as well as the di(butyl) ester, the examiner failed to find the criticality or unexpected results derived from the bi(butyl) ester in applicant's working examples. Accordingly, it would have been obvious to one having ordinary skill in the art to substitute the mono(butyl) ester in the initiator system of WO-475 with a homologue such as di(butyl) ester in view of their closely related structures and the resulting expectation of similar decomplexer properties, absent a comparative showing of the contrary.

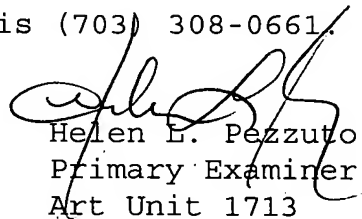
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L.

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Pezzuto whose telephone number is (703) 308-2393. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Helen E. Pezzuto
Primary Examiner
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hlp